

### REMARKS

Claims 1-6, and 8-30, and 32-42 are pending in the above-identified application, claim 7 having been canceled and claim 32 having been withdrawn from consideration. Claims 1-6, 8, 12, and 41-42 stand rejected under 35 U.S.C. § 103(a). Claims 1-6, 8-30, and 32-42 stand rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully request reconsideration of the claims in light of the amendments and remarks made in this response.

With this amendment, claims 1-6, 8, 12, and 41-42 have been canceled without prejudice as to further prosecution of these claims in a continuing application. Claims 9 and 11 have been amended to place the claims in independent format. Claims 13-30 have been amended to update the dependency of each claim.

None of these amendments adds new matter. Their entry is respectfully requested.

### **Rejection Under 35 U.S.C. § 112**

Claims 1-6, 8-30, and 32-42 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Specifically, the Office Action contends that the term “organic tertiary base” is indefinite. (Office Action at p. 2, 2<sup>nd</sup> full para.)

Applicants respectfully disagree and submit that the term provides the requisite degree of clarity and particularity. MPEP § 2173.02. The term “organic tertiary base” is known to those of skill in the art, as exemplified by U.S. Patent Nos. 6,919,450 (claim 4), 5,118,766 (claim 8), and 4,110,326 (claims 11 and 12), all of which include this term in their claims. Moreover, each of the terms in this phrase has a well recognized meaning. MPEP § 2173.02 *citing Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004) (finding a claim term not indefinite because “the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence”). The modifier “organic” in this phrase distinguishes these bases from mineral bases (*e.g.*, NaOH, KOH, *etc.*). For example, “organic base” is defined as “the amines and alkaloids” in Grant and Hackh’s Chemical Dictionary (5<sup>th</sup> Ed. 1987), which is provided in Attachment A. Similarly, the modifier “tertiary” is well known to those of skill in the art. With regard to the amines and alkaloids of the above example, “tertiary” refers to the core nitrogen

atom. Thus, isopropyl amine (the example in the Office Action) is not an organic tertiary base because only one of the hydrogen atoms of the base ammonia structure ( $\text{NH}_3$ ) has been replaced with a non-hydrogen group (in this case, with an alkyl group). Thus, it is a primary amine, not a tertiary amine. This definition is also consistent with the specification and the remaining claims. For example, claim 4 recites triethylamine, DMAP and diisopropyl ethyl amine as exemplary organic tertiary bases, all of which include tertiary nitrogen atoms (*i.e.*, all three of the atoms bonded to the core nitrogen are other than hydrogen).

For the forgoing reasons, Applicants submit that the term “organic tertiary base” is not insolubly ambiguous and provides a sufficient degree of particularity and distinctness to apprise one of ordinary skill in the art of its scope. *See* MPEP § 2173.02. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

#### **Rejection Under 35 U.S.C. § 103**

Claims 1-6, 8, 12, and 41-42 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over EP 232966, alone or in view of McOmie, *Protective Groups in Organic Chemistry*, p. 198 (“McOmie”) or U.S. Patent No. 4,891,369 (“the ‘369 patent”), and also in view of U.S. Patent No. 6,268,393 (“the ‘393 patent”), Nagao, Evans, Crimmins, Brown, Fukuzawa, or Mukaiyama.

Solely in an effort to expedite prosecution of the remaining claims, claims 1-6, 8, 12, and 41-42 have been canceled, rendering this rejection moot. Accordingly, Applicants request that this rejection be withdrawn.

#### **Double Patenting**

Claims 1-6, 8-30, and 32-42 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31, 33-40 of copending U.S. Patent Application No. 10/427,666 (“the ‘666 Application”).

Applicants stand prepared to cancel the relevant claims of the ‘666 Application when the pending claims are found to be allowable.

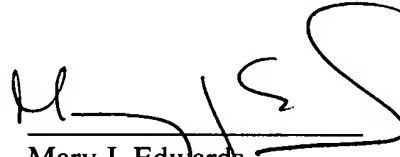
**Conclusion**

In view of the foregoing amendment and remarks, Applicants submit that all pending claims are in condition for allowance, which action is earnestly solicited.

Applicants respectfully request an early and favorable reconsideration and issuance of this application as amended herein. The Examiner is encouraged to contact the undersigned to expedite prosecution of this application.

No fees are believed to be due in connection with this submission. However, if any fees are due in connection with this application, the Director is hereby authorized to charge any fees due, or credit any overpayment, to Wilmer Cutler Pickering Hale and Dorr LLP Deposit Account No. 08-0219.

Respectfully submitted,

  
Mary J. Edwards  
Reg. No. 55,140

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Wilmer Cutler Pickering  
Hale and Dorr LLP  
60 State Street  
Boston, Massachusetts 02109  
Telephone: (617) 526-6215  
Facsimile: (617) 526-5000